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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,226	03/18/2004	Mark S. Cordes	JWB-2003-14-P	5632

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EXAMINER

DESAI, HEMANT

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/803,226	Applicant(s) CORDES, MARK S.	
	Examiner Hemant M Desai	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because something is amiss with the applicant's description and drawings. For example, note that numeral 22b is used in each of Figs. 2, 3, and 6 to refer to three distinct elements. The numeral 22a refers to a different element in each of Figs. 2 and 3. The same problem exists with respect to numeral 33a and 33b in Figs. 4 and 5. Fig. 3 looks suspiciously like back view of the pocket blank itself rather than the glue flap as indicated. Likewise, Fig. 5 looks like back view of the pocket blank rather than the glue flap.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

Art Unit: 3721

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: For example, part (b) of claim 1 refers to a glue flap defined by a longer top side, "a shorter bottom side and two side edges" but the specification at page 7 refers to the "glue flap 22 which is defined by the longer top and bottom sides 22a and 22b, and the short sides 22c and 22d." the same inconsistencies exist between what is recited in claim 1 and what is described on page 8 in reference to Fig. 4. The description bridging pages 8 and 9 of the specification is particularly confusing since it is not clear from the drawing how the side edges 22a can be aligned with the lower side edge 10a of the half sheet 13 as stated.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-4 rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. There is no way to tell without unreasonable speculation how the pocket sheets are attached to the sheet 10. For example, the specification and the drawings confuse the pocket sheet (figs. 3 and 5) and the glue flap. Observe that 22b refers to the bottom side edge of the glue flap in Fig. 2, clearly refers to a different side edge in Fig. 3, and then refers to the top edge of the pocket in

Art Unit: 3721

the finished product shown in Fig. 6. The specification near the bottom of page 7 refers to Fig. 3 as showing the glue flap with the adhesive strips. Yet, the numerals in Fig. 3 do not correspond to those in Fig. 2 and the outline of the substrate in Fig. 3 looks like the outline of the pocket itself as can be seen in Fig. 6. But the numeral 22b does not designate the same thing in Figs. 3 and 6. There is no discussion or explanation of how the pocket sheets of Figs. 2 and 4 are attached to the sheet 10 other than the mere statement that they are attached. It cannot be determined just how the pocket sheet is attached to the sheet 10. Claim 1 itself requires, in part (a) that the glue flap be on the short tapered bottom edge of the pocket sheet, but the glue flap is clearly shown on the non-tapered edge of the pocket sheet. In sum, the claimed invention lacks utility because a finished folder having the appearance of that shown in Fig. 6 would not result from the process claimed when the claims are construed in light of the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For the reasons set forth above, there is no way to tell without unreasonable speculation how the pocket sheets are attached to the sheet 10.

Art Unit: 3721

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Because claim 1 requires the pocket sheet panels as having a short tapered bottom edge with a glue flap. Since this does not comport with a described or illustrated embodiment, the structure defined is not reasonably clear. This becomes important and compounds the lack of clarity when the step (c) of claim 1 requires the flap bottom edge to be folded over the top edge. Taking the claim as a whole in light of the specification, one cannot reasonably tell what would infringe and what would not infringe.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 3, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over welt (5141485).

Welt discloses a method of making a presentation folder (10, fig. 4) having attached folder (25, fig. 4) comprises forming a fold line (12, fig. 2) in a generally rectangular sheet folder (10, fig. 1), the fold line dividing the sheet into a left folder (16, fig. 2) panel, and a right folder panel (14, fig. 2), each of the panels having a longer side

Art Unit: 3721

edge, a top side edge and a bottom side edge (see fig. 3), forming a fold line (22, 24, fig. 3) in at least one generally rectangular pocket sheet (20, fig. 3), having longer side edge (34, fig. 3) a short top edge (see fig. 3) and a short tapered bottom edge (36, fig. 3), a glue flap (28, 30, fig. 3), folding the glue flap, providing two adhesive strips (44, fig. 3, see col. 4, lines 39-56) on the glue flap, removing the double-sided adhesive strips and attaching the pocket sheet to one half of said rectangular sheet.

Welt, does not disclose expressly the shape of the blank of the pocket sheet identical as Applicant's shape of the blank of the pocket sheet.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the shape of the blank of the pocket sheet as disclosed by the applicant because applicant has not disclosed that the particular shape of the blank of the pocket sheet provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the pocket made out of the blank taught by Welt or the pocket made of the blank of claim 1 because both the pockets perform the same function of holding the loose papers.

Therefore, It would have been an obvious matter of design choice to modify Welt to obtain the invention as specified in claim 1.

Regarding claim 3, the sheet folder is generally square in configuration (see fig. 2).

11. Claims 2 and 4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Welt in view of Gentile et al. (4636179) or Miller (4989777).

The modified method of making a presentation folder having attached folder of Welt meets all the claimed limitations, except for two pockets are formed with each pocket being attached to one of the folder panels.

However, Gentile et al. and Miller teach two pockets (see fig. 1 of both Gentile et al. and Miller) are formed with each pocket being attached to one of the folder panels. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide each pocket on each side of the folder panels as taught by Gentile and Miller in the method of making a presentation folder of Welt to hold more papers in the folder.

Regarding claim 4, the sheet folder is generally square in configuration (see fig. 2).

Response to Arguments

12. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 7:00 AM-5:30 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant M Desai
Examiner
Art Unit 3721

HMD

A handwritten signature in dark ink, appearing to read 'Rinaldi I. Rada', with a long horizontal flourish extending to the right.

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700